

### **REMARKS**

Claims 1-60 stand rejected in the Office Action. Applicants have amended claims 1, 16, 28, and 35. Upon entry of the Amendments, claims 1-60 remain pending.

Support for the Amendments is found in the specification as originally filed, for example in paragraph 17. Applicant respectfully requests entry of the Amendments.

### **TELEPHONIC INTERVIEW WITH EXAMINER SANDERS**

Applicant would like to thank Examiner Sanders for the courtesies extended to his Representative in a Telephone Interview on April 18, 2006. The outstanding rejections were discussed. Although final agreement was not reached with respect to any claims, it was agreed that Applicant would address the issues raised in his next response.

### **DOUBLE PATENTING REJECTION**

Claims 1-7 and 9-43 are rejected for double patenting over claims 1-60 of the Wilson reference (U.S. Patent 6,620,871). The rejection appears to be a statutory type of double patenting rejection, since as stated the claims if allowed, would improperly extend the "right to exclude" already granted in the '871 patent. Applicant respectfully traverses the rejection and requests reconsideration.

The '871 patent, issued to the current inventor, Thomas Wilson III, claims various inventions based on rubber compositions containing rubber, curing agent, and certain titanium or zirconium compounds. But the '871 patent does not disclose or claim the non-petroleum oil that is the subject of the rejected claims. Applicant has amended claims 1, 16, 28, and 35 to make

clear that the claims require the presence of the non-petroleum oil. This limitation is completely missing from the claims of the '871 patent.

For statutory double patenting, a reliable test is whether any composition could be made that would infringe the '871 patent without infringing the current claims, and vice versa. It is readily seen that, because the current claims recite at least one limitation completely absent from the '871 patent, the claims do not claim the same invention as the patent. Accordingly, Applicant respectfully requests that the double patenting rejection, as applied to the amended claims, be withdrawn.

#### **OBVIOUS TYPE DOUBLE PATENTING**

Claims 1-60 are rejected under the judicially created doctrine of obviousness type double patenting over claims 1-60 of the '871 patent as applied to claims 1-41, and further in view of the Teratani reference (U.S. Patent 5,001,185) and the Hakuta reference (U.S. Application Publication. No. 2003/096,904). Applicant respectfully traverses the rejection as applied to the amended claims and requests reconsideration.

As noted, Applicant has amended claims 1, 16, 28, and 35 to clarify that the compositions contain non-zero amounts of the non-petroleum oil at a level up to and including 5 phr. The '871 patent is completely silent as to the presence in the rubber compositions of the non-petroleum oils recited in the current claims. The current claims further recite the limitation that the non-petroleum oil comprises fatty acid side chains wherein at least 50% of the fatty acid side chains has one or more sides of unsaturation. This limitation is completely missing from the disclosure of the '871 patent.

The Teratani and Hakuta references do not make up for the deficiencies of the '871 patent.

In particular, the Teratani reference does not disclose rubber compositions containing non-petroleum oil at a level of less than or equal to 5 phr. The passage at column 3, lines 19-24 cited in the Office Action does not disclose these components of a rubber composition. Rather, the cited passage discloses “process oil” without further definition. Applicant respectfully submits that such a disclosure is not of a non-petroleum oil as recited in the claims. Elsewhere, the Teratani reference discloses the use of a novalak type phenolic resin modified with an oil. Applicant respectfully points out that this type of modified phenolic resin contains no free vegetable oil, rather the vegetable oil component is incorporated covalently as part of the phenolic resin. Thus, rubber compositions of Teratani do not contain petroleum oil present at a level of up to 5 phr, and do not contain non-petroleum oil at least partially incorporated into the cured rubber component, as recited in the claims.

Likewise, the Hakuta reference (U.S. Application Publication 2003/096,904) does not make up for the deficiencies of the Wilson reference. The Office Action states that the Hakuta reference teaches castor oil to be an inhibitor, with reference to paragraph 569. Applicant respectfully points out that the Hakuta reference at paragraph 569 states that suitable dripping inhibitors include hydrogenated castor oil and other saturated materials, such as stearate soaps. Applicant respectfully submits that such disclosure is not a teaching of castor oil or any vegetable oil having more than 50% unsaturated side chains, as recited in the amended claims.

Thus, even were the Wilson reference to be combined with the Hakuta and Teratani references, the combination would not lead to the subject matter of the amended claims. For at least this reason, the subject matter of the claims is not obvious in light of the combined references. Accordingly, Applicant respectfully requests the rejection be withdrawn.

## CONCLUSION

For the reasons discussed above, Applicant believes that claims 1-60 as amended are patentable over the cited references. Applicant respectfully submits the claims are in a state of allowability and respectfully requests an early Notice of Allowance. The Examiner is invited to telephone the undersigned if that would be helpful to resolving any issues.

Respectfully submitted,

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